

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) RSW920040065US-09
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number 10711956	Filed October 15, 2004
	First Named Inventor John E. Dinger	
	Art Unit 2167	Examiner Mariela D. Reyes

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

attorney or agent of record. 42,282  
Registration number \_\_\_\_\_

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_



Signature

Frederick D. Bailey

Typed or printed name

919-286-8000

Telephone number

October 30, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

\*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: John E. Dinger et al. )  
Application No.: 10/711,956 ) Confirmation No. 5955  
Filed: October 15, 2004 ) Group Art Unit: 2167  
Title: METHOD AND SYSTEM TO ) Examiner: Mariela D. Reyes  
AUTOMATICALLY DEFINE )  
RESOURCES FORMING AN IT )  
SERVICE )

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Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

**REMARKS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Applicant submits that the Office Action issued by the Examiner in the present application contain clear errors in the Examiner's rejections of claims 1-32 pending in this application.

In the Office Action, claims 1, 2, 13, 18, 23 and 28 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,178,529 (Short et al.). Claim 3 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Short et al. in view of U.S. Patent No. 6,038,677 (Lawlor et al.). Claims 4 – 12, 14 – 17, 19 – 22, 24 – 27 and 29 – 32 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Short et al. in view of U.S. Patent No. 7,069,558 (Stone et al.). Applicant submits that the Examiner has committed clear error in rejecting the claims of the present application as being unpatentable over Short et al.

**Response to Arguments**

In the Advisory Action dated October 27, 2008, in response to Applicant's arguments, the Examiner states that Applicant's Request for Reconsideration does not place the application in condition for allowance. The Examiner then asserts that Short

et al., at col. 5, lines 55-65, discloses tracking resources that have been utilized in responding to a request and forming an IT service by adding the resources used to fulfill that request. However, these portions merely disclose that

Usually a group contains all of the elements needed to run a specific application, and for client systems to connect to the service provided by the application. For example, a group may include an application that depends on a network name, which in turn depends on an Internet Protocol (IP) address, all of which are collected in a single group. In a preferred arrangement, the dependencies of all resources in the group are maintained in a directed acyclic graph, known as a dependency tree, described in more detail below. Group operations performed on a group affect all resources contained within that group.

This is not tracking resources that have been utilized in responding to a request, as recited in the claims of the present application. Moreover, this is not forming an IT service by adding the resources used to fulfill that request. The Examiner commits clear error.

In the Advisory Action, the Examiner states that the cited portions (col. 5, lines 55-65) disclose “that the group or cluster will be created based on the resources needed to run a specific application. Therefore, it is necessary that the resources needed to fulfill a request for an application are going to be tracked. The cluster or group creator will use this information to cluster the needed resources.” As noted above, this is not disclosed in the cited portion. Even if it was, the Examiner fails to understand that resources that have been utilized is completely different from resources needed. One relates to past occurrences and the other to future occurrences. The Examiner commits clear error.

In addition, no portion of Short discloses or suggests tracking resources that have been utilized in responding to a request or set of requests, or performing a transaction or a set of transactions, or automatically defining resources that form an IT service by aggregating all resources utilized to respond to all requests or to perform all transactions, as recited in the claims of the present application. The disclosure in Short et al. relates to components needed to operate a Windows NT service. This is not resources that have been utilized. Further, the disclosure in Short et al. of resources needed to operate is not resources that have been utilized, as recited in the claims of

the present application. Moreover, Short et al. does not disclose or suggest tracking resources that have been utilized in responding to a request or set of requests, or performing a transaction or a set of transactions. The Examiner commits clear error.

### 35 U.S.C. §102 Rejections

Claims 1, 2, 13, 18, 23 and 28 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,178,529 (Short et al.). Regarding claims 1, 13, 18, 23 and 28, Applicant submits that Short et al. does not disclose or suggest the limitations in the combination of each of these claims of, *inter alia*, tracking resources that have been utilized in responding to a request or set of requests, or performing a transaction or a set of transactions, or automatically defining resources that form an IT service by aggregating all resources to respond to all requests or to perform all transactions, or maintaining a record of a union of all resources that have been utilized in responding to each instance of a request or transaction over a selected time period or on a rolling time basis. The Examiner again asserts that Short et al. discloses these limitations in column 4, lines 43 – 54 and column 5, lines 23 – 36. However, as noted previously these portions merely disclose that to accomplish cluster creation and to perform other administration of cluster resources, systems, and the cluster itself, a cluster API is provided where applications and cluster management administration tools call various interfaces in the API, and that a cluster service includes a configuration database manager which implements the functions that maintain a cluster configuration database on a local device such as a disk and/or memory, and a configuration database on the common persistent storage devices where the database maintains information about the physical and logical entities in the cluster, including the cluster itself, systems, resource types, quorum of resource configuration, network configuration, groups and resources. This is not tracking resources that have been utilized in responding to a request or set of requests, or performing a transaction or a set of transactions, as recited in the claims of the present application. The limitations in the claims of the present application relate to responding to a request or set of requests, or performing a transaction or a set of transactions and tracking the resources that have been utilized during the responding. Further, the limitations in the claims of the present application

relate to automatically defining resources that form an IT service by aggregating all resources utilized during the responding. Applicant respectfully requests the Examiner to specifically identify where these limitations are disclosed or suggested in Short et al. The Examiner commits clear error.

The disclosure in Short et al. of an API for cluster creation and performing administration of cluster resources does not disclose or suggest these limitations in the claims of the present application. Further, the disclosure in Short et al. of a cluster service configuration database manager and a cluster configuration database does not disclose these limitations. Moreover, the cited portions of Short do not disclose or suggest automatically defining resources that form an IT service by aggregating all resources utilized to respond to all requests or to perform all transactions, or maintaining a record of the union of all resources that have been utilized in responding to each instance of a request or transaction over a selected time period or on a rolling time basis. Short et al. does not disclose or suggest anything related to resources that have been utilized. The Examiner commits clear error.

#### 35 U.S.C. §103 Rejections

Claim 3 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Short et al. in view of Lawlor et al. Applicant respectfully traverses this rejection and submits that claim 3 is dependent on independent claim 1 and, therefore, is patentable at least for the same reasons noted previously regarding this independent claim. Applicant submits that Lawlor et al. does not overcome the substantial defects noted previously regarding Short et al.

Accordingly, Applicant submits that none of the cited references, taken alone or in any proper combination, disclose, suggest or render obvious the limitations in the combination of claim 3 of the present application. Applicant respectfully requests that this rejection be withdrawn and that this claim be allowed.

Claims 4 – 12, 14 – 17, 19 – 22, 24 – 27 and 29 – 32 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Short et al. in view of Stone et al. Applicant respectfully traverses these rejections and submits that these claims are dependent on one of independent claims 1, 13, 18, 23 and 28 and, therefore, are patentable at least for the same reasons noted previously regarding these independent

claims. Applicant submits that Stone et al. does not overcome the substantial defects noted previously regarding Short et al.

Accordingly, Applicant submits that none of the cited references, taken alone or in any proper combination, disclose, suggest or render obvious the limitations in the combination of each of claims 4 – 12, 14 – 17, 19 – 22, 24 – 27 and 29 – 32 of the present application. Applicant respectfully requests that these rejections be withdrawn and that these claims be allowed.

Accordingly, Applicant submits that neither Short et al. nor any of the other cited references disclose, suggest or render obvious the limitations in the combination of each of the claims of the present invention. The Examiner has committed clear error in making his rejections. Accordingly, as the Examiner's rejections have been shown to be in clear error and lack essential elements of a rejection as required under 35 U.S.C. §102 and §103 and related case law, for the reasons stated above, Applicant respectfully requests that the rejections of Applicant's claims in the present application be withdrawn and that these claims be allowed to issue.

Date: October 30, 2008



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